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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,536	08/21/2003	Yuh-Shen Song	7443-102	9859

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FULBRIGHT AND JAWORSKI L L P
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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,536

Applicant(s)

SONG ET AL.

Examiner

Lalita M Hamilton

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 21, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03032005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because, the use "such as" is improper; "prayer" should be "payer". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 11-12, 16, 20-22, and 26-41 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Leary (US 2003/0140004).

O'Leary discloses a method for processing funds transfer transactions comprising a method for verification and processing of a remote transaction using cash as the payment instrument involving a payer's account at a financial institution, opening a remote payment system account for the payer after verifying the payer's identity, payer's financial institution and the specific account at that institution, authenticating the payer's identity when the payer logs into the remote payment system to conduct a remote transaction using cash as the payment instrument, prompting the payer to enter the payee's name, identification information, and transaction amount into the database of the remote payment system; assigning a transaction identification number which the

Art Unit: 3624

payee will use to identify and request a cash payment, prompting the payee to insert a machine-readable official identification card and enter the assigned transaction identification number into a remote payment system terminal, verifying that embedded identification information read from the payee's identification card at the remote payment system terminal matches the payee information entered by the payer into the remote payment system database and that the specific amount of funds is available from the payer's account at the financial institution, and if the verification of the payee's identity is successful and the specific amount of transaction funds are available, causing said remote payment terminal to issue a cash payment of that specific amount to the payee (p.7, 63-66 and p.12, 109 to p.13, 112); prompting the payer to submit a machine-readable official identification card prior to the opening of said remote payment system account, and opening said the remote payment system account only if embedded identification information read from the payer's identification card matches the account holder information of the financial account identified by the payer (p.3, 23 and p.6, 57-58); prompting the payer to input an additional item of personal information not embedded in the identification card but stored in the remote database of the financial institution, and verifying that the additional personal information input by the payer matches the personal information stored in the remote database (p.3, 23 and p.6, 57-58); prompting the payer to input an additional item of personal information embedded in the identification card but not stored in the remote database of the financial institution, and verifying that the additional personal information input by the payer matches the personal information embedded in the identification card (p.3, 23 and

Art Unit: 3624

p.6, 57-58); prompting the payer to log into the remote payment system with an official identification card, and validating the login only if the embedded identification information read from the payer's identification card matches the account holder information in the remote payment system database (p.3, 23 and p.6, 57-58); prompting the payer to input an additional item of personal information not embedded in the identification card but stored in the database of the remote payment system, and verifying that the additional personal information input by the payer matches the personal information stored in the remote payment system database (p.3, 23 and p.6, 57-58); prompting the payer to input an additional item of personal information embedded in the identification card but not stored in the database of the remote payment system, and verifying that the additional personal information input by the payer matches the personal information embedded in the identification card (p.3, 23 and p.6, 57-58); prompting the payee to input an additional item of personal information not embedded in the identification card but stored in the database of the remote payment system, and verifying that the additional personal information input by the payee matches the personal information stored in the database (p.7, 63-66 and p.12, 109 to p.13, 112); the personal information input by the payee includes at least a password (p.3, 23 and p.6, 57-58); prompting the payee to input an additional item of personal information embedded in the identification card but not stored in the database of the remote payment system, and verifying that the additional personal information input by the payee matches the personal information embedded in the identification card (p.3, 23 and p.6, 57-58); including an escrow agent into the transaction based on the agreement

Art Unit: 3624

between payer and payee, and the payee cannot receive pay (p.4, 28-29); the payer's financial account includes at least a bank account such as checking or savings account (p.14, 125); the payer's financial account includes at least a credit card account (p.14, 125); the payer's financial account includes at least a debit card account (p.14, 125); the remote payment system terminal is incorporated into a self-service machine (p.14, 125); the self-service machine includes at least an ATM terminal (p.14, 125); the self-service machine includes at least a check-cashing terminal (p.14, 125); the self-service machine includes at least a standalone kiosk where cash is available for withdrawal (p.14, 125); the remote payment terminal is installed in a location under the supervision and control of the remote payment system (p.14, 125); the remote payment system secures the payment funds from the specified payer account against the possible payer's fraud before issuing the transaction identification number (p.7, 63-66 and p.12, 109 to p.13, 112); permitting the payer's financial institution to open an account in the remote payment system on behalf of the payer (p.7, 63-66 and p.12, 109 to p.13, 112); the payer's account in the remote payment system is linked to a specific payer's account of the financial institution opening said remote payment system account (p.7, 63-66 and p.12, 109 to p.13, 112); the remote payment system is established exclusively for one financial institution to provide services to the customers of the financial institution (p.7, 63-66 and p.12, 109 to p.13, 112); a wireless data transmission device is incorporated into the identification card and a wireless data receiver reads the machine-readable identification information of the identification card (p.7, 63-66 and p.12, 109 to p.13, 112); a wireless data transmission device is incorporated into the

identification card and a wireless data receiver reads the machine-readable identification information of the identification card (p.7, 63-66 and p.12, 109 to p.13, 112); a wireless data transmission device is incorporated into the identification card and a wireless data receiver reads the machine-readable identification information of the identification card (p.7, 63-66 and p.12, 109 to p.13, 112).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-6, 8-10, 13-15, 17-19, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary in view of Lapsley (US 2001/0000535).

O'Leary discloses the invention substantially as claimed; however, O'Leary does not disclose the personal information input by the payer includes at least part of a social security number, the personal information input by the payer includes at least biometric information, or the biometric information input by the payer includes at least a

Art Unit: 3624

fingerprint. Lapsley discloses a biometric electronic transaction method comprising the personal information input by the payer includes at least part of a social security number (p.3, 33-34 and p.5, 79-80), the personal information input by the payer includes at least biometric information (p.3, 33-34 and p.5, 79-80), and the biometric information input by the payer includes at least a fingerprint (p.3, 33-34 and p.5, 79-80). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the personal information input by the payer includes at least part of a social security number, the personal information input by the payer includes at least biometric information, and the biometric information input by the payer includes at least a fingerprint, as taught by Lapsley into the invention disclosed by O'Leary, to provide additional alternatives of verifying identity to protect accounts against theft.

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the

Art Unit: 3624


provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH